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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,353	07/27/2001	Francis Pruche	010830-119	6986

7590 07/16/2003

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EXAMINER	
BAHAR, MOJDEH	

ART UNIT	PAPER NUMBER
1617	20

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 09/915,353	Applicant(s) PRUCHE ET AL.	
	Examiner Mojdeh Bahar	Art Unit 1617	

-- The MAILING DATE of this communication appears n the c ver sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,27-34 and 45-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25,27-34 and 45-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2003 has been entered.

Applicant's remark about claims 46-47 is persuasive and these claims are examined herein. Claims 21-25, 27-34, and 45-63 are herein examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Note that these claim recite "a compound consisting of an admixture of...compounds". Note that a compound cannot consist of other compounds. The substitution of composition for the first compound would be favorably considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-22, 24-25, 29-31, 45, 48-49, and 51-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Pruche et al. (FR 2787319).

Pruche et al. (FR 2787319) teaches a method of applying a composition comprising 4,5-dihydroxystilbene-3-O-beat-D glucoside, a physiologically acceptable medium and additives to keratinous materials such as hair, see claims 4, 6 20-21 and abstract in particular. The amount of the glucosylated stilbene (0.01-10%) reads on the effective amounts recited in the instant claims.

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 21-25, 27-34, and 45, 48-60 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Pezzuto et al. (WO 01/30336).

Pezzuto et al. (WO 01/30336) teaches a method for treating or preventing skin conditions such as those associated with sun damage and natural aging comprising toically administering a composition comprising a topical carrier (emulsifiers, solubilizers, emollients, preservatives, water) and a prodrug of resveratrol auch as cis or trans resveratrol glucosides, see claims 1-10, 20-21 and 43 in particular. Pezutto et al teaches that resveratrol and its glucosides are art equivalents, see for example claims 1-10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-25, 27-34, and 45-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. (WO 99/04747), Pezzuto et al. (WO 01/30336), and Teguo.

Carson et al. (WO 99/04747) teaches that resveratrol, a phytoestrogen present in red grapes and wine, is useful in methods of inhibiting the proliferation of keratinocytes and

stimulating their differentiation, improving the appearance of wrinkled, lined, dry, flaky, aged or photodamaged skin, improving skin thickness, elasticity, flexibility, radiance, glow and plumpness, see in particular abstract and claims 3-4. Carson et al. (WO 99/04747) also teaches that cosmetic compositions containing grape extract are known in the art, see in particular page 4 lines 23-33.

Pezutto et al teaches that resveratrol and its glucosides are art equivalents, i.e., conditions that are responsive to resveratrol are also responsive to its glucosides, see for example claims 1-10.

Teguo teaches that E and Z piceid, E-astringen and E-Z resveratroloside are found in Vitis vinifera and Polygunum cuspidatum root, see page 655.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ grape extract in Carson et al.'s methods of treating and/or improving skin conditions.

One of ordinary skill in the art would have been motivated to employ grape extract in Carson et al.'s methods of treating and improving skin because grape extract is known to contain both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside), known to be useful in cosmetic compositions. Furthermore the prior art teaches that glucosylated resveratrol is also known to be employed in topical composition used in skin treating compositions.

Response to Arguments

Applicant's arguments filed May 5, 2003 have been fully considered but they are not persuasive. Applicant's arguments have been addressed in so far as they concern the modified rejection herein.

Applicant first argues that Carson et al. only teaches the employment of resveratrol, and does not teach the employment of grape extracts in its method. Note that Carson et al. teaches the employment of grape extract in cosmetic compositions, see page 4, line 23-33. The Skilled Artisan in possession of the teachings of Carson et al., knows about the effects of resveratrol on skin as well as the fact that grape extract (a source of resveratrol) is known to be useful in cosmetic skin compositions. Applicant's IDS contains patents and abstract teaching compositions comprising grape extract employed in skin treatment. Additional compositions are those marketed by Lancôme, in a product line called Vinéfit. Applicant then argues that Carson et al. is silent as to the employment of glucosylated resveratrol in its method. Note that the invention is rendered obvious by the combination of the prior art references employed herein above, not over Carson et al. alone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

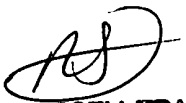
In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 on Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
July 14, 2003



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